

Docket No. P22,577-H USA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE


In re	Application of:	Kohn et al.	
	Application No.:	09/350,423	Art Unit 3743
	Filed:	July 8, 1999	Examiner N. Patel

ANIONIC BIODEGRADABLE POLYMERS DERIVED FROM THE AMINO ACID L-TYROSINE

(Attorney Docket No. P22,577-H USA)

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Nazia Zamir

**Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

Reply to Requirement for Restriction Dated April 20, 2005

Sir:

In response to the Examiner's Action mailed April 20, 2005, applicants hereby traverse the Examiner's Requirement for Restriction set forth therein and respectfully request reconsideration and withdrawal of the Requirement.

The Examiner requires restriction between the following groups of claims:

Group I – The polymer compositions of Claims 1-14 classified in Class 525, Subclass 7.4;

Group II – The methods for using the polymer to deliver medicaments of Claims 21-23 classified in Class 424, Subclass 1.33;

Group III – The methods for attaching cells to a solid substrate of Claims 27-38, classified in Class 435, Subclass 395; and

Group IV – The medical devices for application of medicant of Claims 15 – 20 and 24 – 26, classified in Class 602, Sub-class 641.

The basis for the Examiner's Requirement for Restriction is that he considers the claim groups to be distinct because the medical device of Group IV is capable of dispensing medicaments other than those claimed in Groups I, II, and III and the polymers claimed in Group I can be used for applications other than those recited in Groups II, III, and IV.

It is respectfully submitted that the Examiner's Requirement is deficient on its face because 35 U.S.C. § 121 requires the involved inventions be not only distinct, but also independent. Clearly, the inventions defined in the claims of Groups I, II, III, and IV are not independent in that the Group I claims define a material that is used to prepare the articles and devices of the Group II, III, and IV claims.

The Examiner has recognized the claim groups do not define independent inventions because he has not characterized them as being independent. Moreover, the Examiner has not even attempted in his Action to explain why he considers the claims to be directed to independent inventions. Consequently, the Examiner has issued a requirement that is deficient on its face because he has not explained why the two claim groups are considered to define independent subject matter. Accordingly, the Requirement should be withdrawn.

It is submitted further that the Examiner's Requirement should be withdrawn because a proper search of the subject matter of the four claim Groups requires that a search be conducted for the subject matter of all groups of claims. This is because the subject matter of the claims is so interrelated. For example, the methods, articles, and devices of the Group II, III, and IV claims involve the material of the Group I claims.

As requested by the Examiner, applicants provisionally elect with traverse to prosecute polymer claims 1 – 14 of Group I. Applicants respectfully request that, upon indication of allowable subject matter with regard to the elected claims, withdrawn Group II method claims 21-23, Group III method claims 27-38, and Group IV medical device claims 15-20 and 24-26, which include all the recitations of the polymer claims, be rejoined for examination of patentability (M.P.E.P. Section 821.04).

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It is believed that the claims in this application are in condition for allowance. A favorable action on the merits is respectfully requested. A one-month Petition for Extension of time to respond to the Requirement is also enclosed with the required fee (small entity) of \$60.00. If there are any additional charges in connection with this response, the Examiner is authorized to charge Applicant's Deposit Account No. 23-3040 therefore.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Sarah Klosek", written over a horizontal line.

Sarah Klosek, Esq.
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Date June 7, 2005

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